

## REMARKS

This application has been reviewed in light of the Office Action dated June 30, 2006. Claims 21-27 and 29-38 are presented for examination. Claims 1-20 have been canceled, without prejudice or disclaimer of subject matter, and claim 28 has been canceled and its recitations incorporated into claim 21. Claim 21, 30, and 36 have been amended to define still more clearly what Applicants regard as their invention. Claims 22-27, 29, 31-35, 37, and 38 have been amended as to matters of form and/or to ensure proper claim dependency. Claims 21 and 36 are in independent form. Figures 1-9 have been canceled and Figure 13 has been amended to ensure consistency of reference numbers. Favorable reconsideration is requested.

Claims 1-38 were rejected under 35 U.S.C. § 112, first paragraph, because the best mode contemplated by the inventor has allegedly not been disclosed. The Examiner cites evidence of concealment of the best mode because the description of Figures 1-9 is missing.

Applicants have amended the specification (refer to the Submission of Substitute Specification filed concurrently herewith) to cancel Figures 1-9 and removed reference to these figures from the Brief Description of the Drawings section of the specification. Figures 1-9, corresponding to Figures 1-9 of parent Application No. 10/144,513 which has matured into U.S. Patent No. 6,685,188, were inadvertently included in the specification of the present application. The remaining figures, Figures 10-21, have been renumbered. No new matter to the original disclosure is believed to have been added as a result of these changes.

With respect to the Examiner's comment on page 2 of the Office Action that the description of the reference numbers must be directed to the same structural elements or features throughout the specification, Applicants respectfully request the Examiner provide specific occurrences where the description differs. Applicants have amended Figure 13 to ensure consistency of reference numbers.

The specification has also been amended to update the status of the cross-reference to related application. Specifically, Applicants include the fact that U.S. Patent Application No. 10/144,513 has matured into U.S. Patent No. 6,685,188 which issued on February 3, 2004.

Applicants believe that the rejection under Section 112, first paragraph, has been obviated and respectfully request its withdrawal.

Claims 21-35 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asserts that the claimed structural method steps fail to clearly recite communication steps or communicating between different members of the first party user only.

Applicants have reviewed the claims, in particular independent claim 21, and have amended claim 21 to clearly recite a communication step. It is believed that the rejection under Section 112, second paragraph, has been obviated and respectfully request its withdrawal.

Claims 1-10 and 12-17 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 10-21 of U.S. Patent No. 6, 685, 188 (“the Rehbein ‘188 patent”).

Claims 21-29 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 10-21 of the Rehbein ‘188 patent in view of U.S. Patent No. 5,974,372 (“the Barnes ‘372 patent”).

Claims 30-38 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 10-21 of the Rehbein ‘188 patent in view of the Barnes ‘372 patent and further in view of U.S. Patent Publication No. 2002/0169691 (“the Yukimachi ‘691 publication”).

First, cancellation of claims 1-20 renders the rejection of those claims moot.

As shown above, Applicants have amended independent claims 21 and 36 in terms that more clearly define what they regard as their invention. Applicants submit that these amended independent claims, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The rejection of claim 21 will be discussed first.

Claim 21 is directed to a method for enabling communication between first and second parties. The method includes providing an electronic device adapted to display at least one digital transactional flash card from a plurality of transactional flash cards stored in a memory. The digital transaction flash card comprises a first text understandable to the first party and a second text understandable to the second party and an image, wherein both texts describe the image. The method further includes selecting at least one digital transactional flash card from the memory, displaying the at least one digital transactional flash card, and communicating, by the first party, the at least one transactional flash card to the second party.

A user profile including digital transactional flash card data created by the first party is stored in the memory, and the electronic device further comprises a navigational system comprising a

plurality of cross-linked pages that allow the first party to select the stored flash cards from a plurality of cross-referenced groups.

The Examiner states on page 5 of the Office Action that the Rehbein '188 patent does not specifically disclose a user profile and a navigational system but that the teachings of the Barnes '372 patent teaches that such features of a user profile (Figs. 20-22) and a navigational system (Figs. 13, 17-19, and 23-26) are old and well known, and are considered an arbitrary obvious design choice. Applicants respectfully disagree with the Examiner's characterization of the Barnes '372 patent.

The Barnes '372 patent, as understood by Applicants, relates to the translation of screen displays of a software application and, more particularly, to a method for translating screen displays of an application program from its base language into one or more foreign languages. Figure 20 of the Barnes '372 patent presumably depicts an example display of a software application program in English. Figures 21 and 22 depict the screen display of Figure 20 in Spanish and Japanese, respectively. The Description of the Preferred Embodiment section of the Barnes '372 patent fails to mention or describe Figure 20. Although Figure 20 appears to identify various data relating to a user, the figure fails to depict a user profile including digital transactional flash card data. As mentioned previously, Figures 21 and 22 are merely translations of the screen display of Figure 20.

With regard to the feature of a navigational system comprising a plurality of cross-linked pages that allow the first party to select the stored flash cards from a plurality of cross-referenced groups, the Examiner asserts that Figures 13, 17-19, and 23-26 depict a navigational system and thus presumably teaches the navigational system of claim 21. Figure 13 of the Barnes '372 patent depicts a graphical user interface/screen display of the translation program which effects the method of the Barnes '372 patent. The icons depicted in Figure 13 indicate to a user that translation tables are available in the program memory. Figures 17 and 18 are input screens that require a user to enter various data, such as the type of language, the name to be associated with certain fields, the location of the translation tables to be created, the type of window classifications to be used when effecting subsequent translations of screen displays. Figure 19 is an interface displayed once initial parameters desired by the translator program have been received. Figures 23 and 25 are presumably sub-screen displays associated with the Figure 20 screen. Figures 24 and 26 are the sub-screen displays of Figures 23 and 25, respectively, in a

different language. (The Description of the Preferred Embodiment section of the Barnes '372 patent fails to mention or describe Figures 23-26).

Applicants have found nothing in the Barnes '372 patent, much less Figures 13, 17-19 and 23-26 of the Barnes '372 patent, that teaches or suggests a navigational system comprising a plurality of cross-linked pages that allow the first party to select the stored flash cards from a plurality of cross-referenced groups, as recited in claim 21.

Further, Applicants assert that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. The Examiner on page 5 of the Office Action asserts that both the Rehbein '188 patent and the Barnes '372 patent are directed to a method of enabling communication between first and second parties, so as to provide the user's information and allow selection of stored information to assist the need party. Applicants disagree with the Examiner's characterization of the Barnes '372 patent. As mentioned previously, the Barnes '372 patent relates to the translation of screen displays of a software application and, more particularly, to a method for translating screen displays of an application program from its base language into one or more foreign languages. That is, the Barnes '372 patent provides a method for translating the graphical user interface/screen displays without modification to the underlying application program. The Barnes '372 patent does not enable communication between first and second parties, much less allow a user to select stored information to assist a need party. Accordingly, Applicants assert that there is no motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. Rather, Applicants submit that the Examiner's combination of the references is simply a hindsight reconstruction of the claims. Although determinations of obviousness take into account the collective teachings of the prior art and level of ordinary skill in the art, there must be some suggestion, teaching or incentive in the prior art, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. *Carella v. Starlight Archery*, 804 F.2d 135, 140 (Fed. Cir. 1986). "[T]he question is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would 'suggest the desirability, and thus the obviousness, of making the combination.'" *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1498 (Fed. Cir. 1986).

*In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984), the Federal Circuit stated that there must be some teaching or suggestion in the prior art references themselves without recourse to the invention whose patentability is at issue, that supports the combination of the references relied upon in making the rejection. In reversing a Board of Appeals decision which upheld a rejection based upon prima facie obviousness, the CAFC held that:

The mere fact that the prior art *could* be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. *Id.* (emphasis added)

Applicants submit that the Examiner has not met his burden of showing that the prior art suggested the modification. Indeed, quite to the contrary, one of ordinary skill in the art would not be motivated to add a method for translating screen displays of an application program to a method of enabling communication between first and second parties who are two parties who do not understand each other's language for conducting a transaction.

For at least the above reasons, Applicants submit that a combination of the Rehbein '188 patent and the Barnes '372 patent fail to teach or suggest at least those features of claim 21.

The rejection of claim 36 will now be discussed.

Claim 36 is directed to a method of enabling communication between first and second parties. The method includes providing a first electronic device having a display. The device is adapted to store a plurality of digital transactional flash cards in a memory so that at least one flash card may be viewed on the display. The method further includes selecting at least one digital transactional flash card from the memory, displaying the at least one digital transactional flash card comprising a first text understandable to the first party and a second text understandable to the second party and an image, wherein both texts describe the image, and providing the second party with a second electronic device having a display. The device is also adapted to receive through wireless or wired transmission from the first party a list comprising at least one digital transactional flash card that may be viewed on the display of the second electronic device. At least one of the first and second electronic devices has a user profile which includes digital transactional flash card data stored in the memory, and the electronic device further comprises a navigational system comprising a plurality of cross-linked pages that allow the first party to select the stored flash cards from a plurality of cross-referenced groups.

For the reasons discussed above, neither the Rehbein '188 patent nor the Barnes '372 patent discloses or suggests the user profile and navigation system of claim 36. The Yukimachi '691 publication is cited by the Examiner as disclosing the features of wired communication. Applicants wish to point out that claim 36 recites both wired and wireless communication. The Office Action fails to address the wireless transmission of data, as recited in claim 36.


Nothing has been found in the Yukimachi '691 publication that teaches or suggests the user profile and navigational systems of claim 36. Therefore, for at least the reasons discussed above in connection with claim 21, Applicants submit that claim 36 is patentable over the cited art.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the above, it is respectfully submitted that the present application is in a condition for allowance. A favorable disposition to that effect is respectfully requested. Should the Examiner have any questions or comments concerning this submission, he is invited to call the undersigned at the phone number identified below.

Respectfully submitted,

Date: November 28, 2006

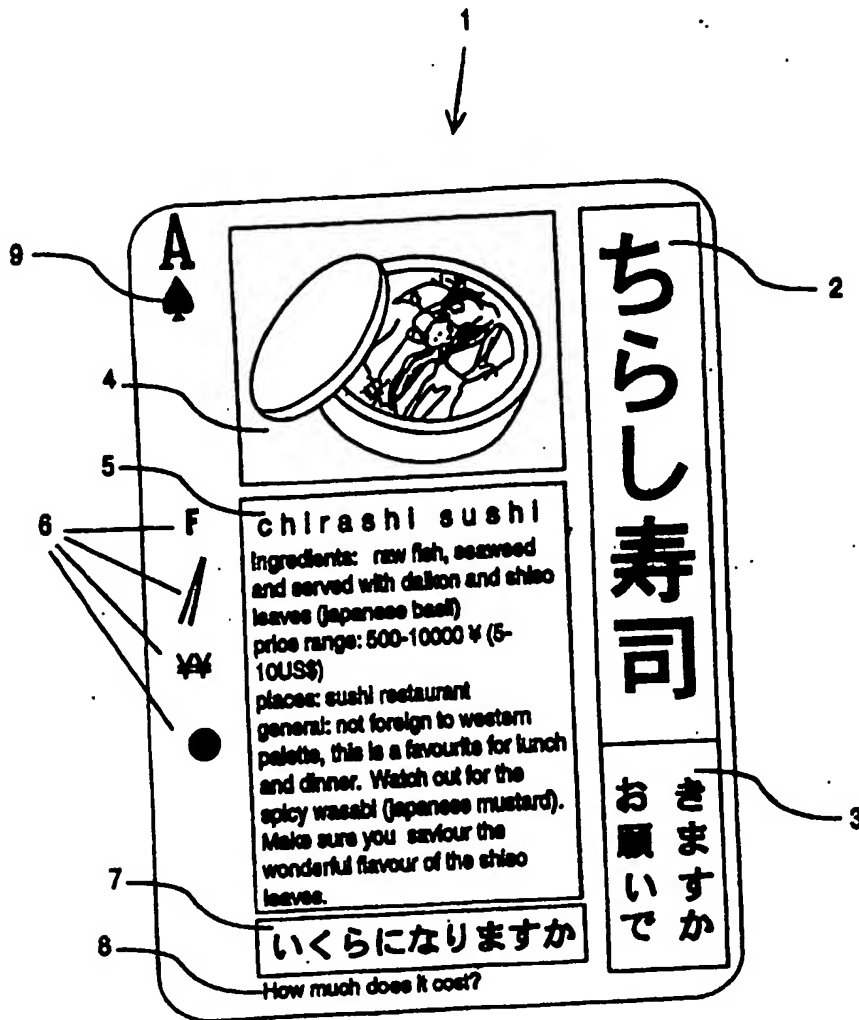
  
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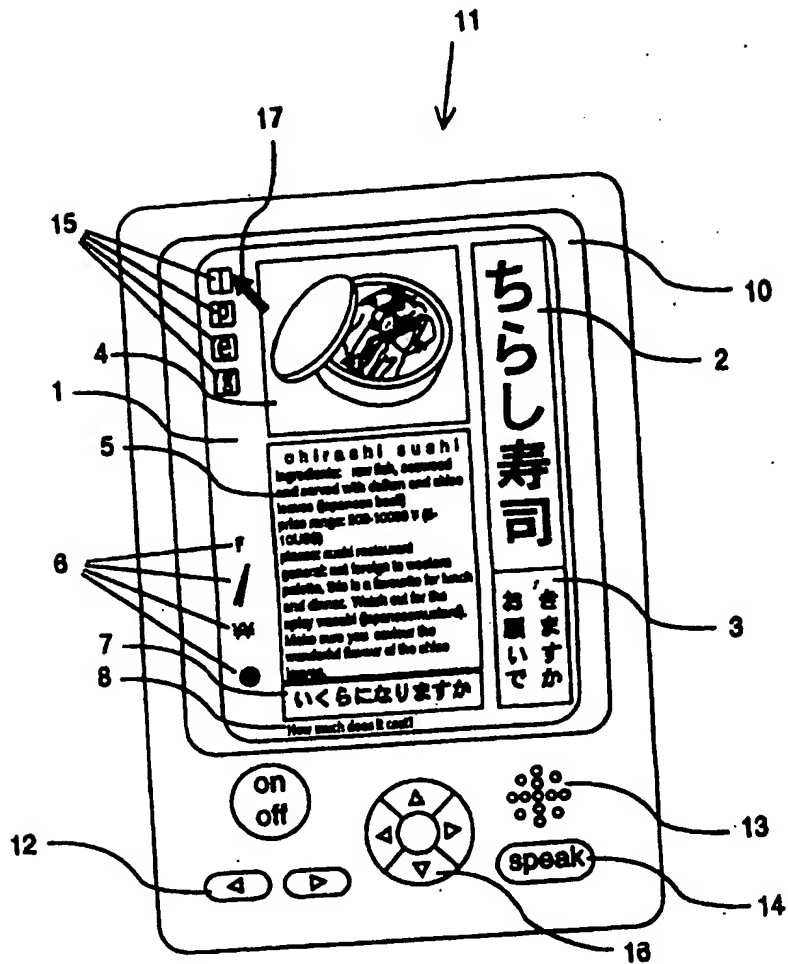


ANNOTATED SHEET  
FOR ORIGINAL FIG. 1



CANCELED

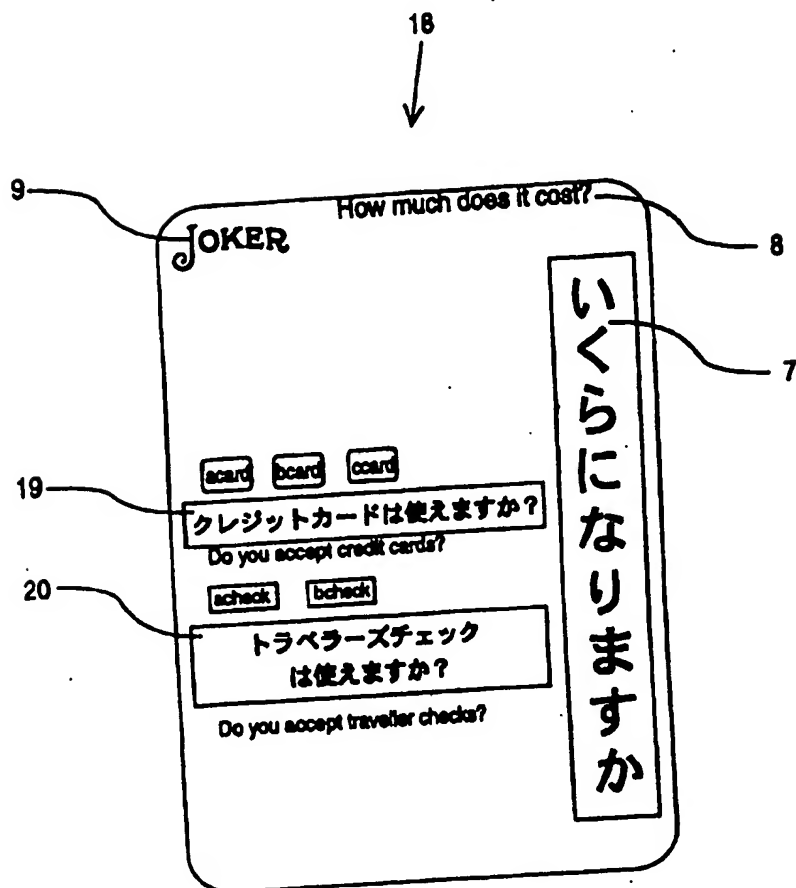
# ANNOTATED SHEET FOR ORIGINAL FIG. 2



CANCELED



ANNOTATED SHEET  
FOR ORIGINAL FIG. 3



CANCELED

ANNOTATED SHEET  
FOR ORIGINAL FIG. 4

18

9

JOKER

How much does it cost?

21

145.99 ¥

22

exchange rate: 153.55

19

acard bcard ccard

20

い え ん う つ  
Do you accept credit cards?

23

あ い え い ち う  
Do you accept traveller checks?

い つ い ん ち ゅ う  
Hotel Tokyo Palace

Do you deliver/ship?  
delivery/shipping address:

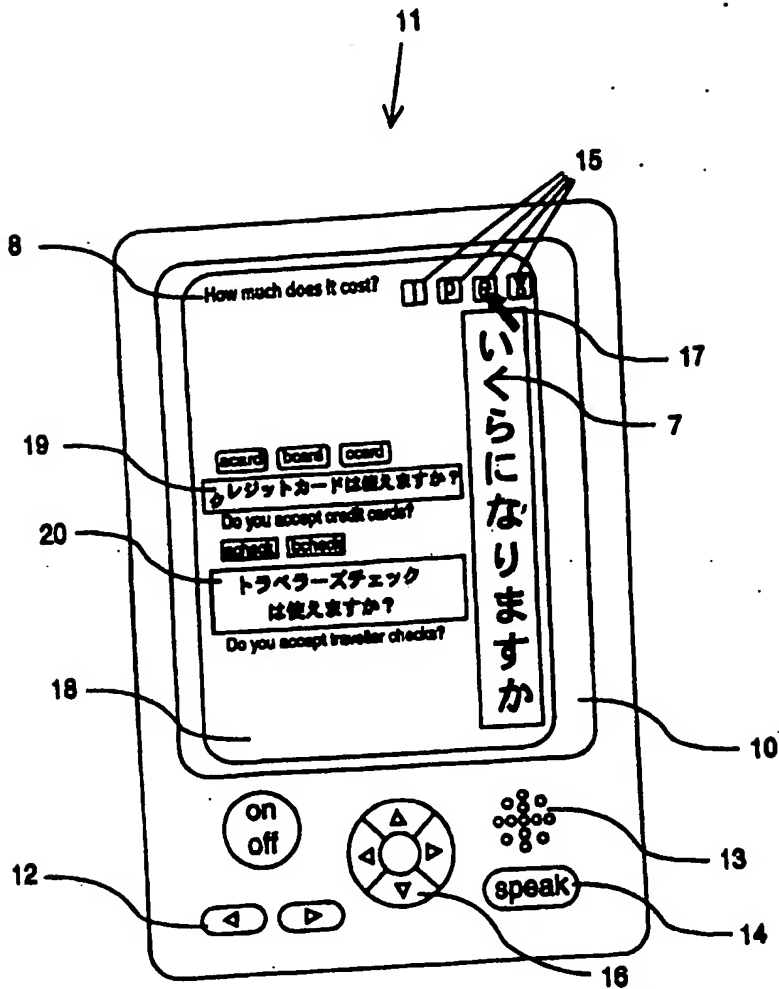
8

7

いくらになりますか

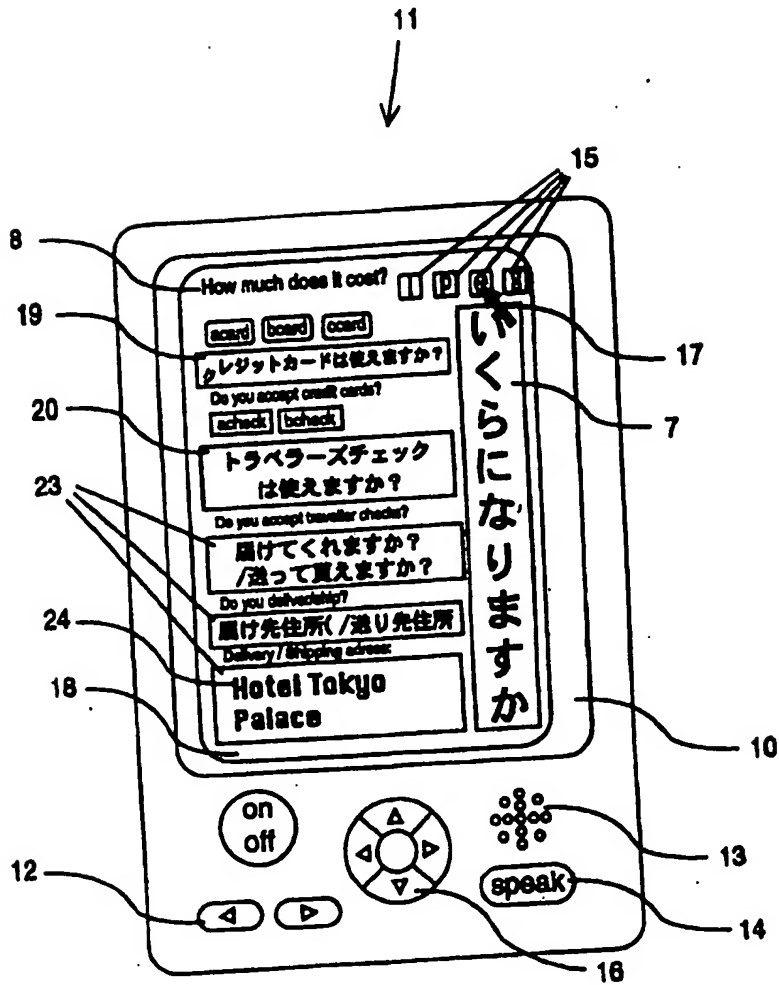
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# ANNOTATED SHEET FOR ORIGINAL FIG. 5



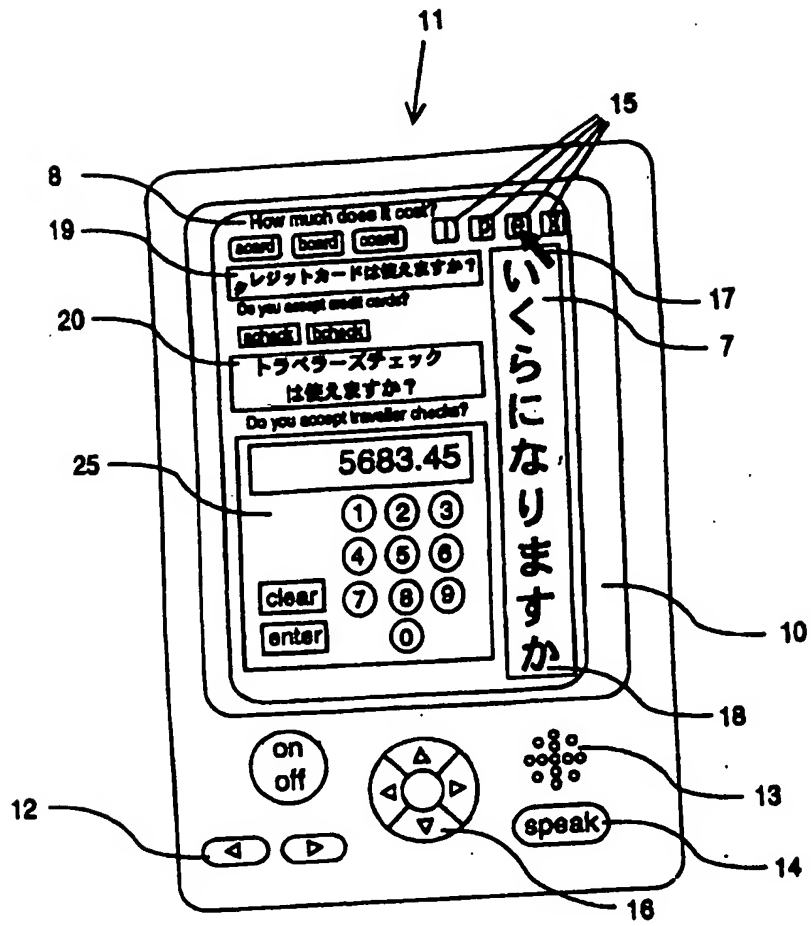
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# ANNOTATED SHEET FOR ORIGINAL FIG. 6



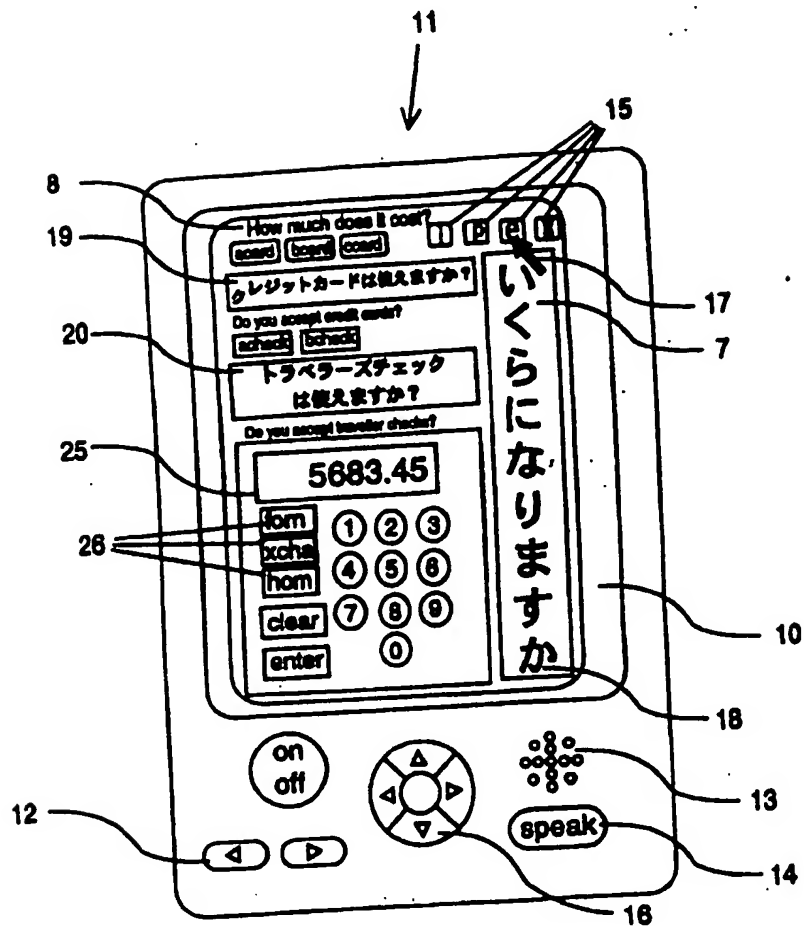
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ANNOTATED SHEET  
FOR ORIGINAL FIG. 7



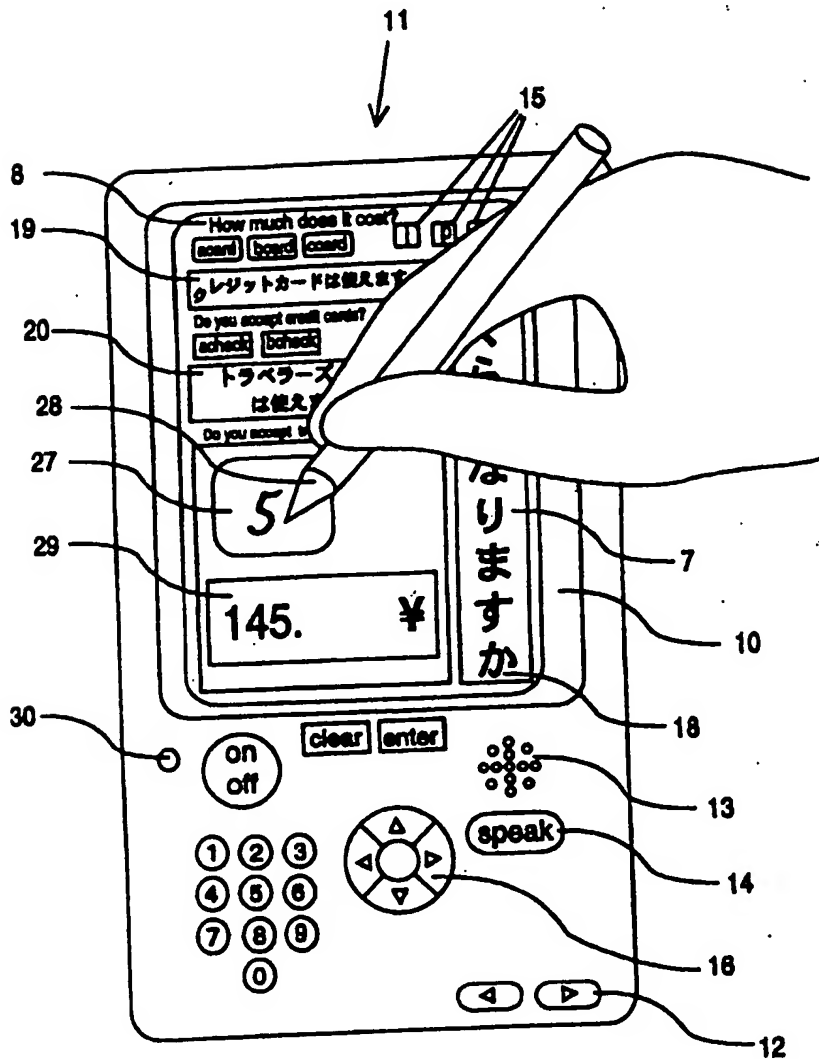
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ANNOTATED SHEET  
FOR ORIGINAL FIG. 8



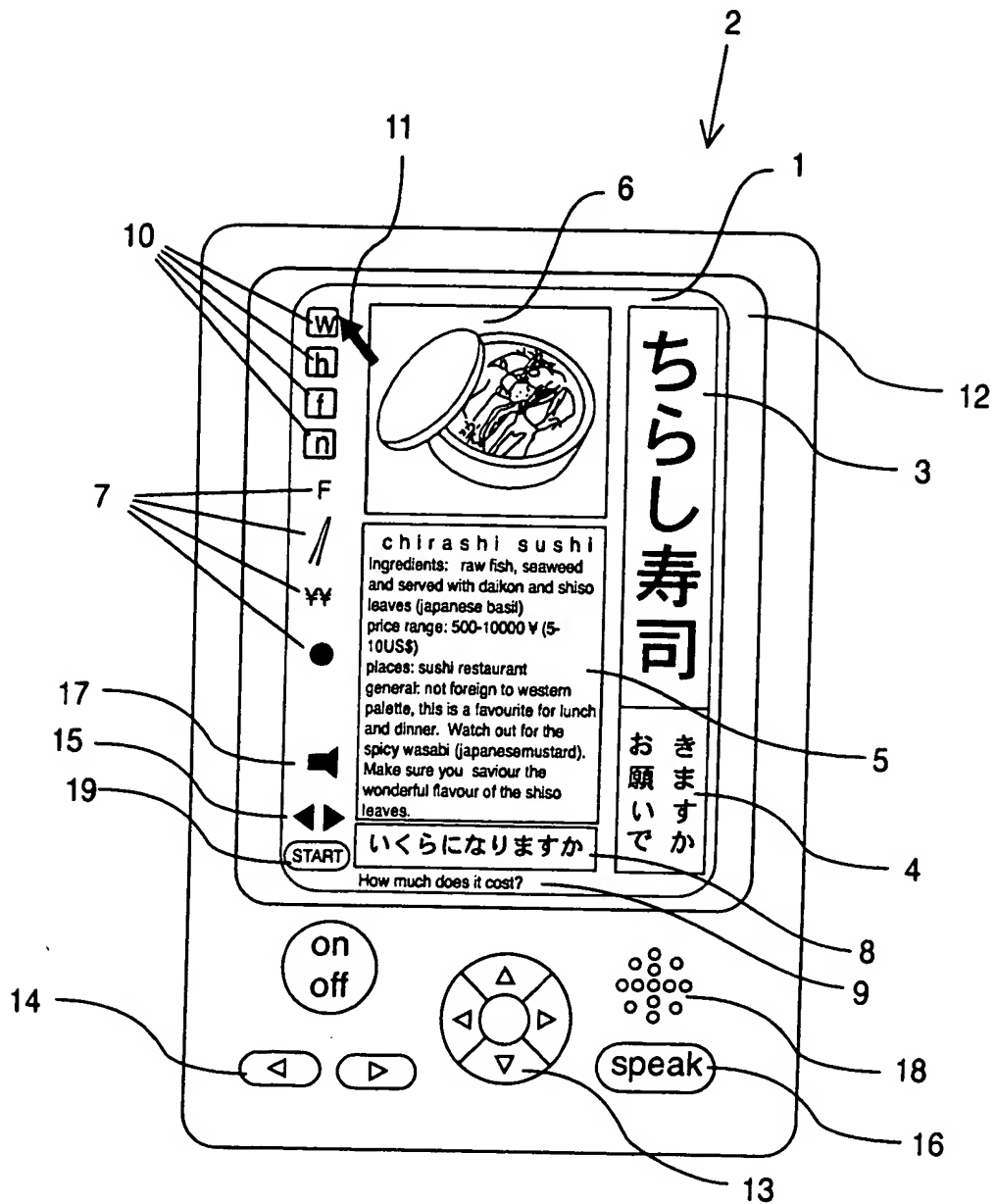
CANCELED

# ANNOTATED SHEET FOR ORIGINAL FIG. 9



CANCELED

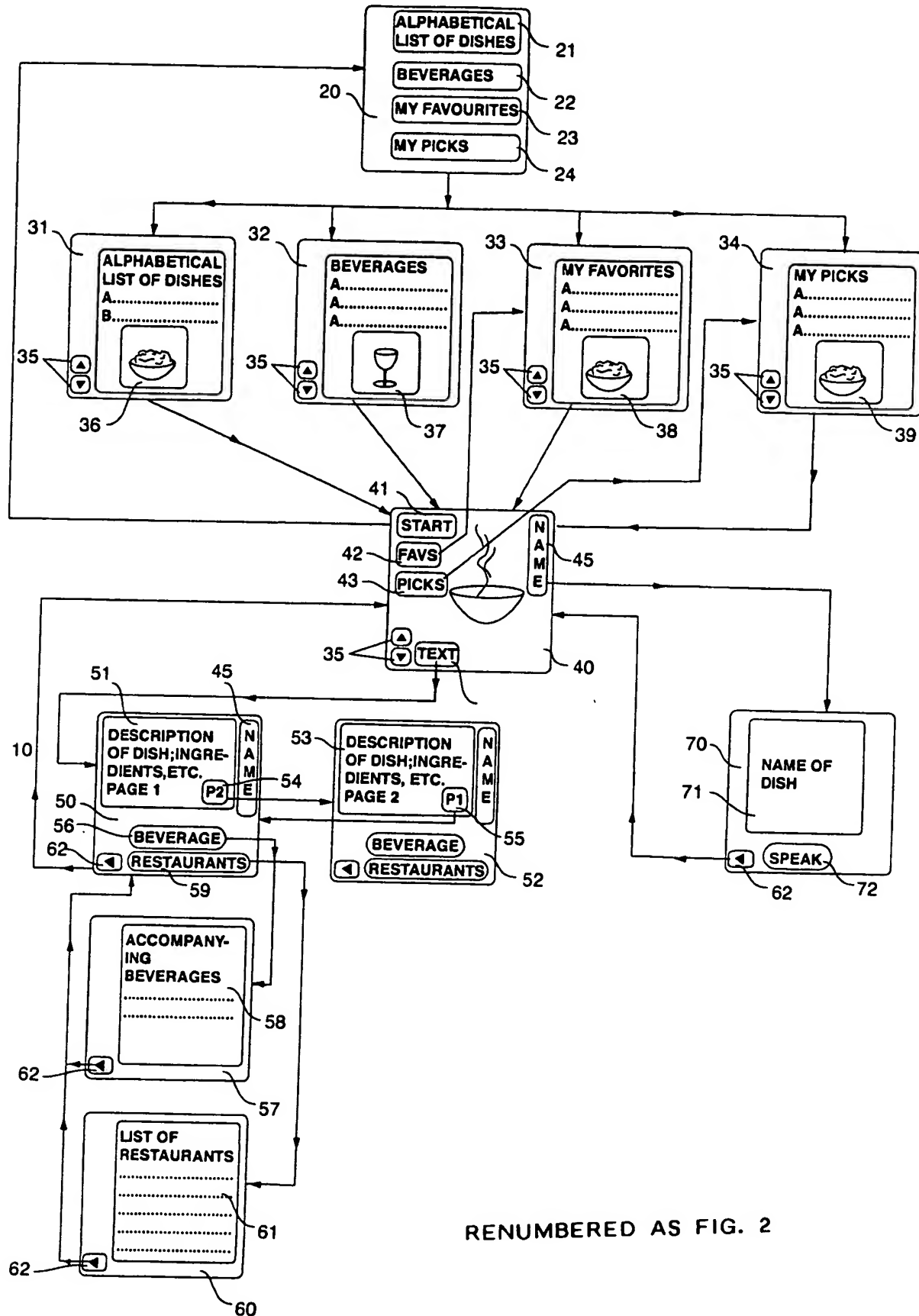
# ANNOTATED SHEET FOR ORIGINAL FIG. 10



RENUMBERED AS FIG. 1

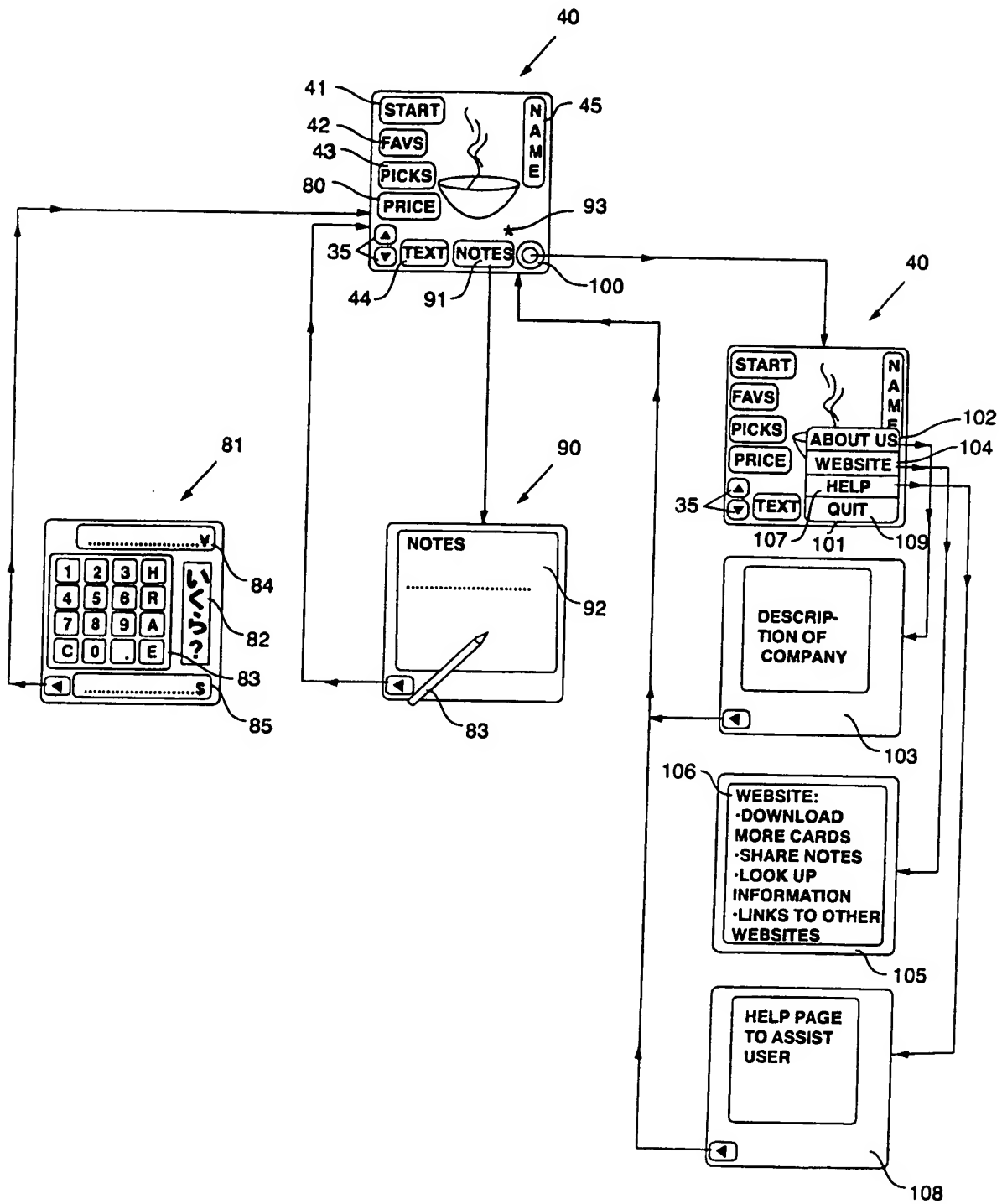


# ANNOTATED SHEET FOR ORIGINAL FIG. 11



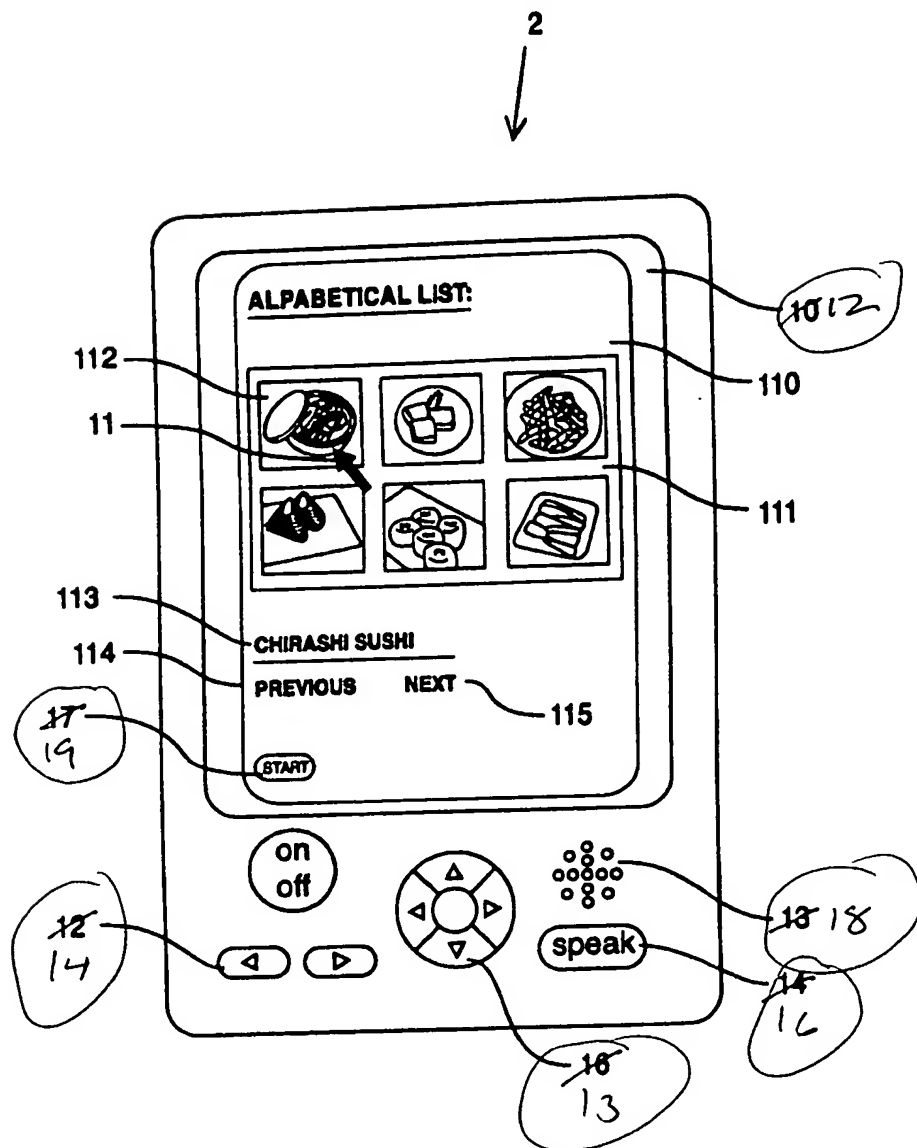
RENUMBERED AS FIG. 2

# ANNOTATED SHEET FOR ORIGINAL FIG. 12



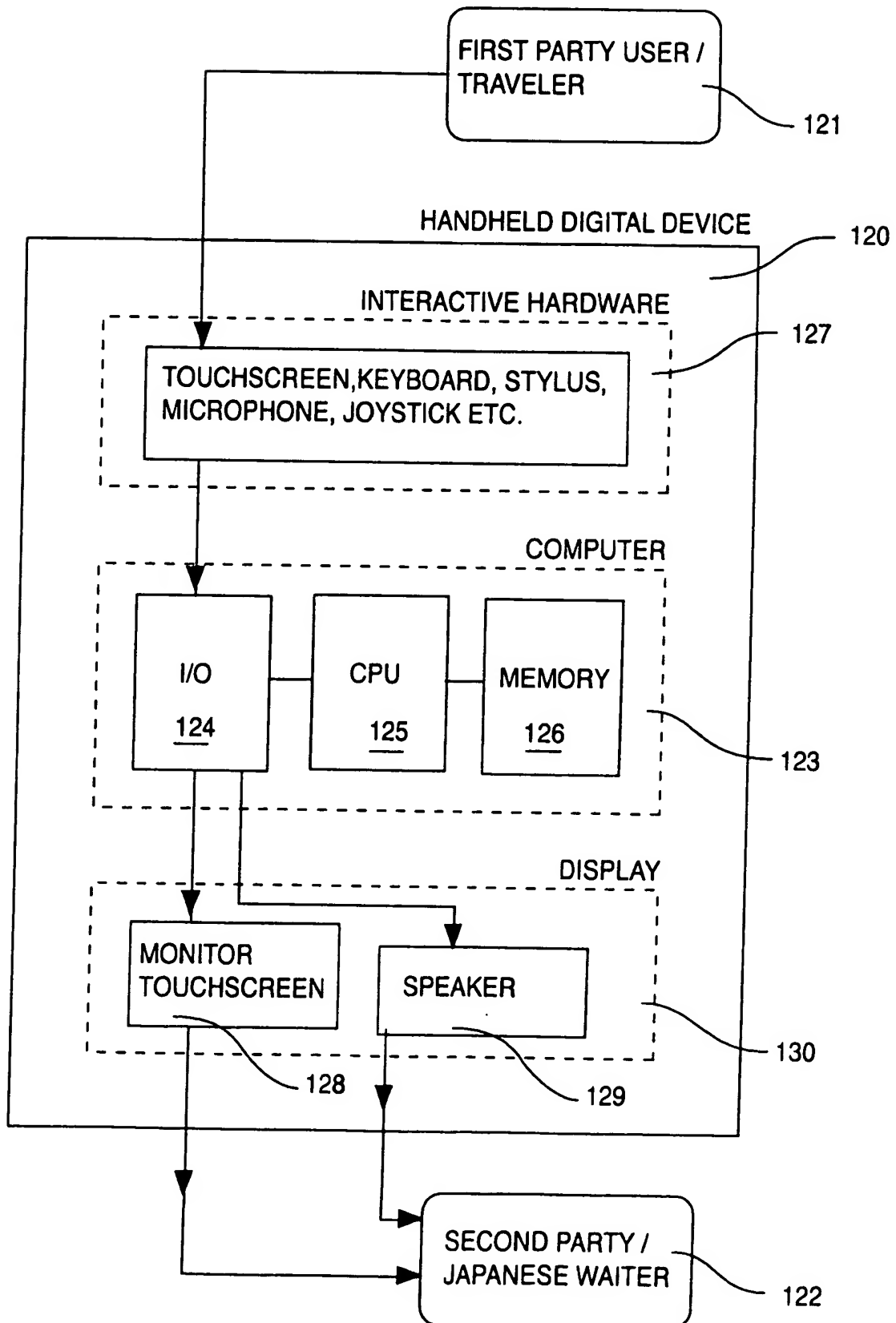
RENUMBERED AS FIG. 3

ANNOTATED SHEET  
FOR ORIGINAL FIG. 13

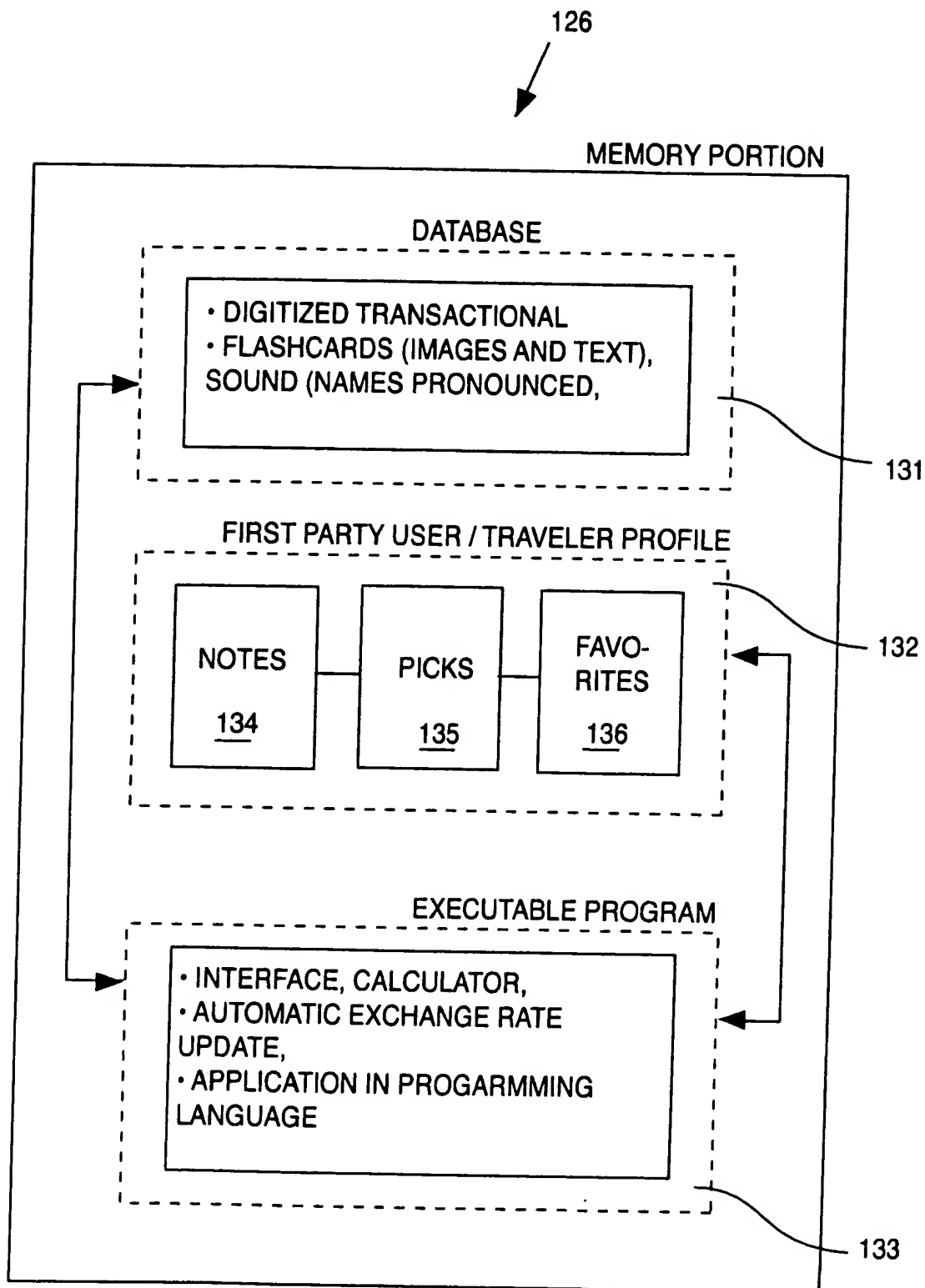


RENUMBERED AS FIG. 4

ANNOTATED SHEET  
FOR ORIGINAL FIG. 14

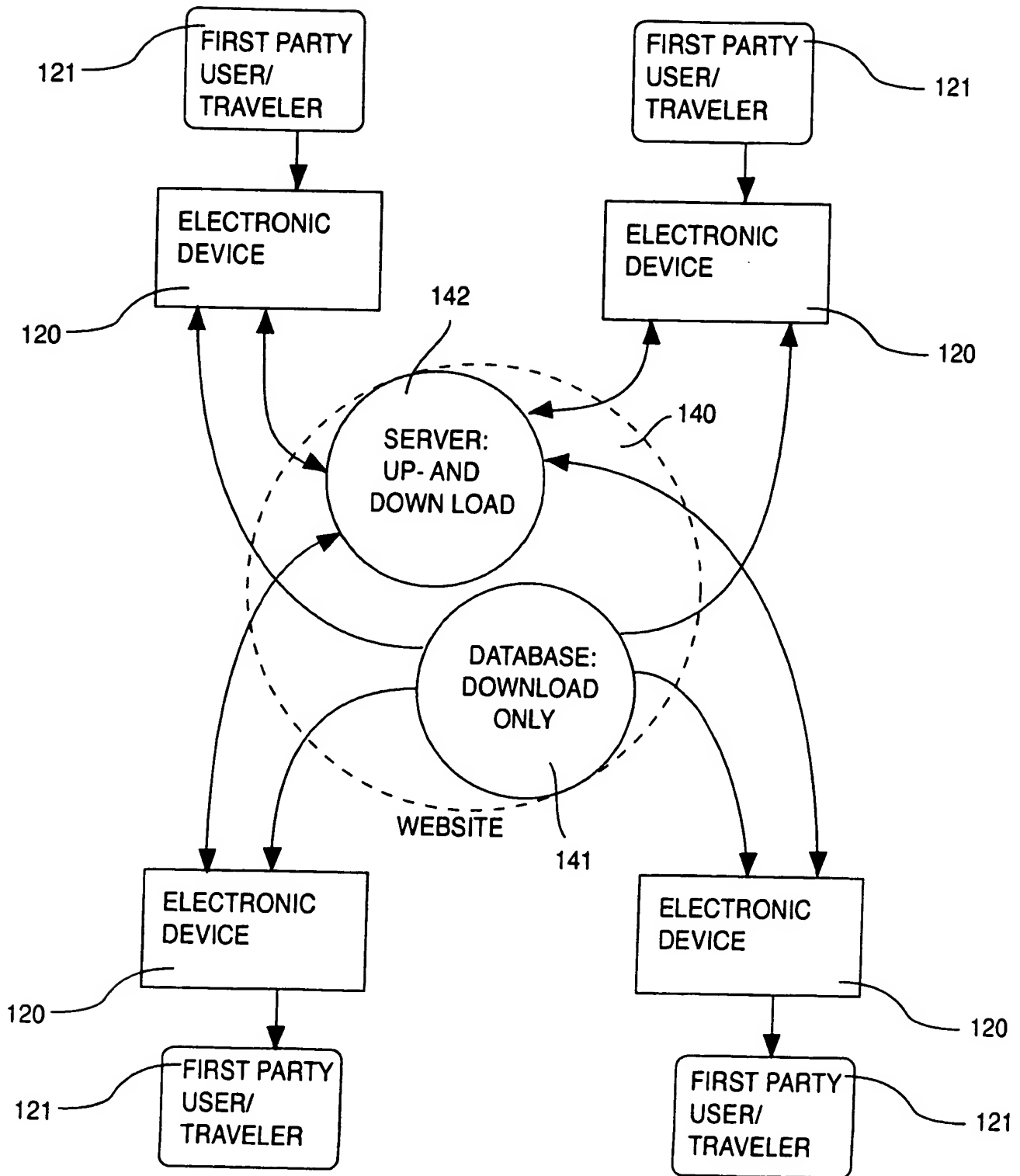


ANNOTATED SHEET  
FOR ORIGINAL FIG. 15



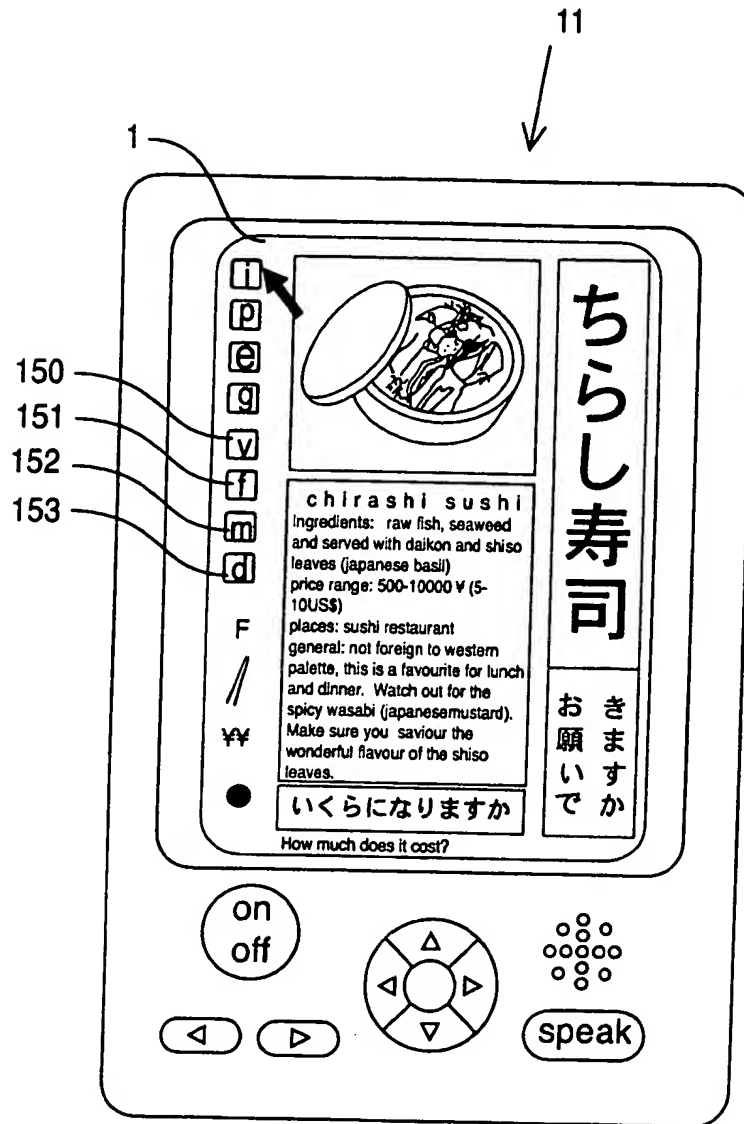
RENUMBERED AS FIG. 6

ANNOTATED SHEET  
FOR ORIGINAL FIG. 16



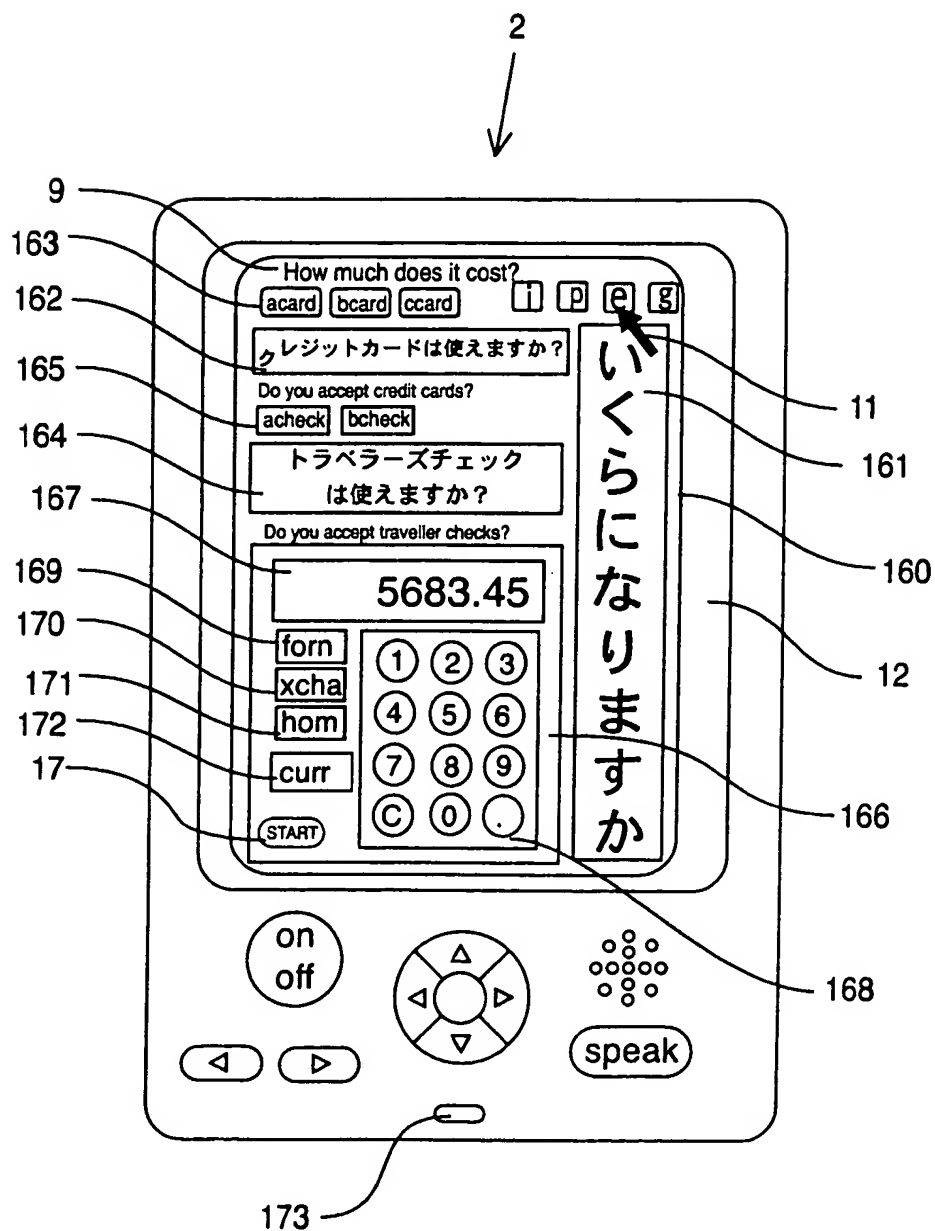
RENUMBERED AS FIG. 7

# ANNOTATED SHEET FOR ORIGINAL FIG. 17



RENUMBERED AS FIG. 8

# ANNOTATED SHEET FOR ORIGINAL FIG. 18



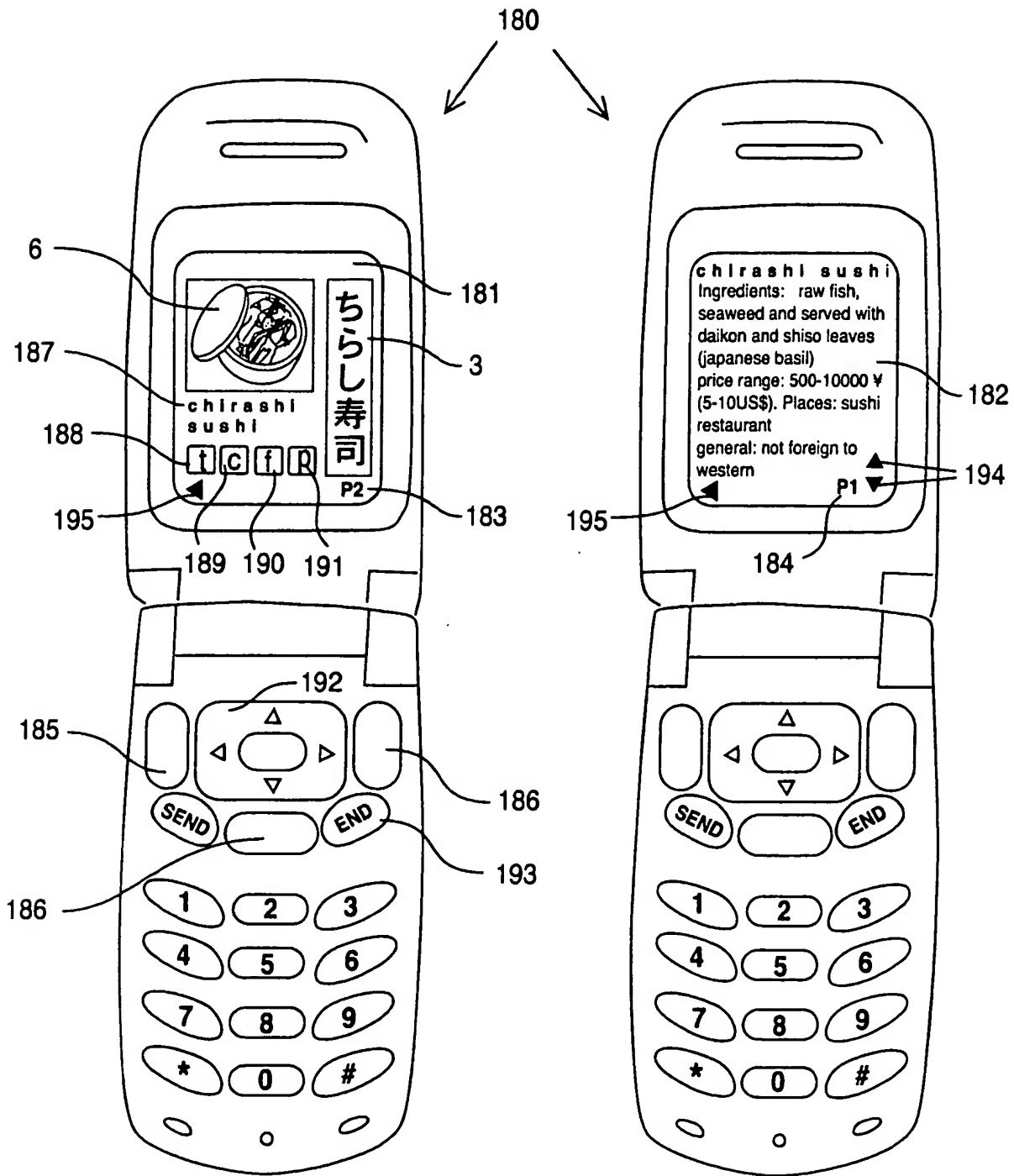
RENUMBERED AS FIG. 9



# ANNOTATED SHEET

## FOR ORIGINAL

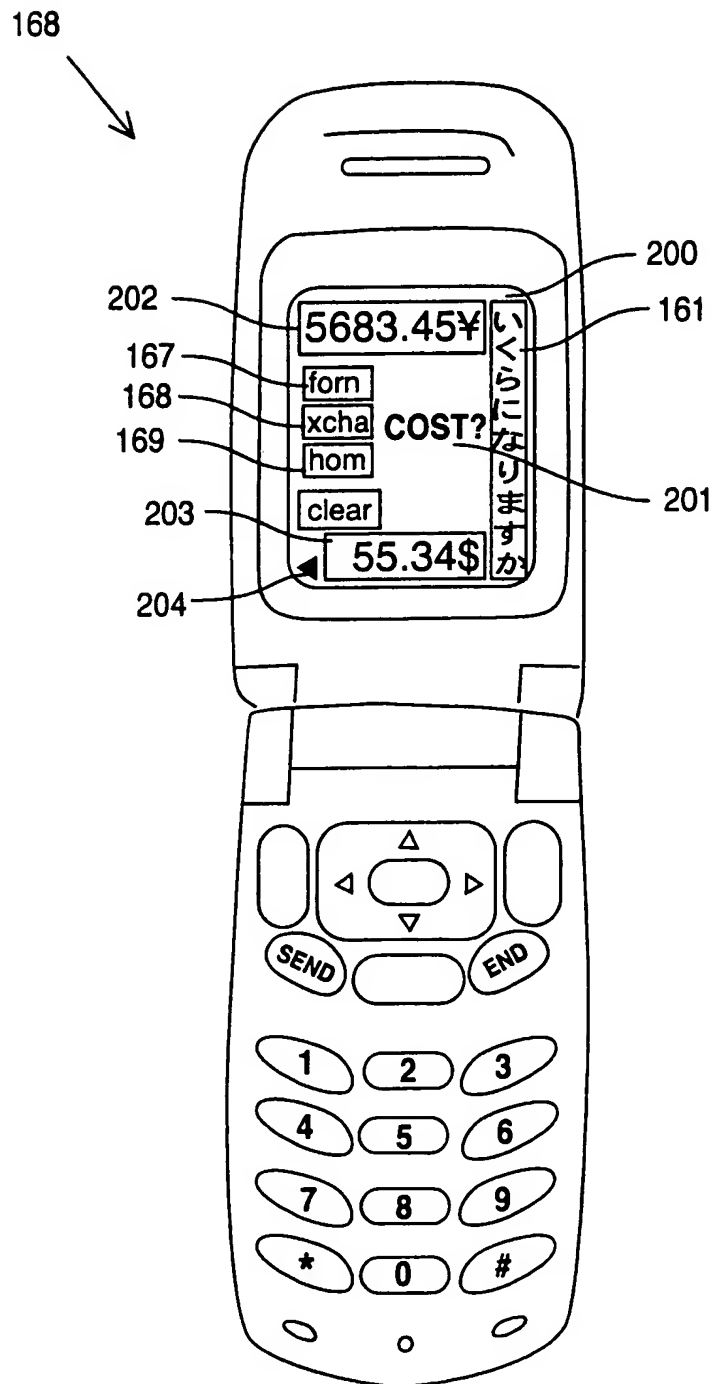
### FIGS. 19 & 20



RENUMBERED AS FIG.10

RENUMBERED AS FIG.11

ANNOTATED SHEET  
FOR ORIGINAL FIG. 21



RENUMBERED AS FIG.12